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PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q60940

Kanji NAKANISHI

Appln. No.: 09/688,134

Group Art Unit: 2145

Confirmation No.: 9987

Examiner: Mitra Kianersi

Filed: October 16, 2000

For: NETWORK DATA TERMINAL AND DATA PRINTING METHOD THEREFOR

SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

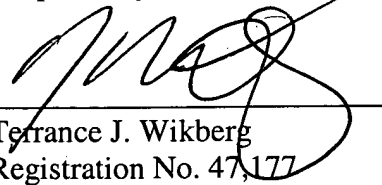
P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. A check for the statutory fee of \$500.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,


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WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: February 23, 2005



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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MAIL STOP APPEAL BRIEF - PATENTS

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Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

The real party in interest is Fuji Photo Film, Co., Ltd. of Japan, by virtue of an assignment executed by Kanji Nakanishi ("Appellant" hereafter) on September 14, 2000 and filed in the United States Patent and Trademark Office on October 16, 2000. The recordation of the assignment has not yet been received from the USPTO.

II. RELATED APPEALS AND INTERFERENCES

To the knowledge and belief of Appellant, the Assignee, and the undersigned, there are no other appeals or interferences before the Board of Appeals and Interferences that will directly affect or be affected by the Board's decision in the instant Appeal.

III. STATUS OF CLAIMS

Claims 1-18 are pending in the application.

Claims 1-18 are rejected.

The rejection of claims 1-18 is being appealed.

IV. STATUS OF AMENDMENTS

All amendments are believed to have been previously entered and made of record.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 of Appellant's invention recites a network data terminal 10 for printing information obtained from a network comprising (FIG. 1; p. 7, line 9+): a printer 12 that is connectable to or incorporated into the data terminal, and is capable of printing on opposite sides of a recording sheet (p. 7, lines 12-14; p.9, lines 8-23); a memory device 32 for storing ad data received from the network (p. 8, lines 22-28); a device 17 for allowing a user of the data terminal to choose whether to print the ad data on the same side of a recording sheet as the information or on the opposite side from the information (p. 7, lines 19 - p.10, line 20; FIG. 2); a print control device 35 that produces print image data for one side or for both sides from the information and the ad data in accordance with which side of the recording sheet the ad data is to print, and controls the printer in accordance with the print image data (p. 7, lines 22-27; p. 9, lines 8-23); and a charge modification data sending device 36 for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information (p. 7, lines 22-27; p. 9, lines 24-26).

Independent claim 4 of Appellant's invention recites a network data terminal 10 for printing information obtained from a network comprising (FIG. 1; p. 7, line 9+): a printer 12 that is connectable to or incorporated into the data terminal, and is capable of printing on opposite sides of a recording sheet (p. 7, lines 12-14; p.9, lines 8-23); a memory device 32 for storing ad data received from the network (p. 8, lines 22-28); a sorting device 17 for detecting a category of the information to print, and automatically sorting out those ad data relating to the category of the information (p. 9, line 27 - p. 11, line 12); a print control device 35 that produces

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print image data from the information and the ad data sorted by the sorting device, and controls the printer in accordance with the print image data (p. 7, lines 22-27; p. 9, lines 8-23); and a charge modification data sending device 36 for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information (p. 7, lines 22-27; p. 9, lines 24-26).

Independent claim 7 of Appellant's invention recites a printing method for printing information obtained from a network by use of a printer that is connectable to or incorporated into a data terminal of the network, the method comprising the steps of (FIGS. 2, 3A and 3B): storing ad data received from the network (p. 10, lines 2-5); detecting a category of the information to print (p. 10, line 27 - p. 11, line 3); sorting out those ad data relating to the category of the information (p. 11, lines 4-12); printing the sorted ad data along with the information (p. 11, line 13 - p. 12, line 7); and modifying charge for provision of the information in accordance with the amount of ad data printed with the information (p. 12, line 8 - p. 13, line 4).

Independent claim 10 of Appellant's invention recites a printing method for printing information obtained from a network by use of a printer that is connectable to or incorporated into a data terminal of the network, the method comprising the steps of: storing ad data received from the network (p. 10, lines 2-5); printing the information on an obverse side of a recording sheet, while printing the ad data on a reverse side of the recording sheet (p. 10, lines 14-16); and modifying charge for provision of the information in accordance with amount of ad data printed with the information (p. 12, line 8 - p. 13, line 4).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu (US 5,987,230) in view of Yokomizo et al. (US 6,321,266).

VII. ARGUMENT

Appellant respectfully submits that the claims are not obvious over the applied references.

Argument 1: Shimizu does not teach or suggest a device for allowing a user of the data terminal to choose whether to print the ad data on the same side of a recording sheet as the information or on the opposite side from the information as described by claim 1.

In the Amendment of April 12, 2004, Appellant argued that Shimizu fails to disclose the device for allowing a user of the data terminal to choose whether to print the ad data on the same side of a recording sheet as the information or on the opposite side from the information, as recited in claim 1. See page 7. In response to this argument, the Examiner points to col. 1, lines 62-63 of Shimizu, which discloses two-sided printing control. See Office Action dated June 23, 2004 at p. 2. The Examiner asserts that the two-sided printing control corresponds to a printer that is connectable to or incorporated into the data terminal and is capable of printing on opposite sides of a recording sheet. However, these alleged disclosures of the reference do not correspond to the above-recited features of claim 1. As described above, claim 1 recites a device for allowing a user of the data terminal to choose whether to print the ad data on the same side of a recording sheet as the information or on the opposite side from the information. Appellant submits that Shimizu is silent regarding such a device. The ability of a printer to print on two sides of a medium does not necessarily imply a selection of which of the two sides is to be printed. The Examiner may not properly speculate that this selection is occurring in maintaining the rejection. Shimizu does not even suggest a manner by which a user can choose a side of a recording sheet to print ad data with respect to the information obtained from a network.

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Furthermore, Yokomizo fails to make up for the above-described deficiency of Shimizu.

Hence, claim 1 is allowable.

Argument 2: Shimizu does not teach or suggest a print control device that produces print image data for one side or for both sides from the information and the ad data in accordance with which side of the recording sheet the ad data is to print, and controls the printer in accordance with the print image data as described by claim 1.

Appellant argued in the April 12, 2004 Amendment that Shimizu does not teach or suggest the feature of claim 1 of a print control device that produces print image data for one side or for both sides from the information and the ad data in accordance with which side of the recording sheet the ad data is to print, and controls the printer in accordance with the print image data. See page 7. The Examiner's response to this argument refers to col. 1, lines 60-65; col. 2, lines 8-9; and col. 4, line 44 of Shimizu. See Office Action dated June 23, 2004 at page 2.

However, none of the cited excerpts of the reference teach or suggest the above-described features of claim 1. Specifically, these excerpts only indicate that "the allocation of the optimum raster memory banding varies, in the case of an extension of the memory capacity, according to the presence of two-side printing control, the internal raster resolution of the printing process, and the nature of the data (principally image or characters) within the page description language." Shimizu, col. 1, lines 60-65. However, claim 1 recites that the print control device produces the print image data in accordance with which side of the recording sheet the ad data is to print. The raster memory referenced in this passage fails to disclose or teach this feature of the claimed invention, for at least two reasons. First, the raster memory is not a print control device which produces print image data, as claimed. There is no disclosure or teaching of the raster memory producing print image data. Second, the raster memory, in Shimizu, fails to

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disclose or teach a print control device that produces the print image data in accordance with which side of the recording sheet the ad data is to print. Namely, there is no disclosure or teaching that the cited raster memory is a print control device that produces print image data in accordance with which the side of the recording sheet the data is to be printed. Therefore, Shimizu fails to disclose a print control device as set forth in the claims of the present application. Also, Yokomizo fails to disclose the claimed print control device.

Thus, claim 1 is allowable for this reason also. (*See also* claim 4)

Argument 3: Yokomizo does not teach or suggest a charge modification data sending device for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information as described by claim 1.

The Examiner concedes that Shimizu does not disclose the charge modification data sending device of claim 1. Appellant argued in the April 12, 2004 Amendment that Yokomizo also fails to teach or suggest a charge modification data sending device for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information. See pages 7-8. The Examiner responded in the June 23, 2004 Office Action by referring to the disclosure in Yokomizo of an Ethernet controller 113, in col. 16, lines 41-44. See page 2 of the Office Action. However, the cited excerpt only discloses the following: "The Ethernet controller 113 performs a control of electric timings and a control of data transmission and receipt. TCP/IP communication program 82 is controlled by the CPU 101 by utilizing the Ethernet controller 113." Clearly, this excerpt does not disclose the claimed charge modification data sending device, which modifies the charge for the information in accordance with amount of ad data printed with the information. Col. 16, lines 41-44 does not even relate to the concept of charging for information. Hence, claim 1 is allowable for this

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additional reason. Claims 13-16 specify that the charge modification relates to a cost to be paid by a user. The interface features cited by the Examiner do not pertain to any such costs.

Therefore, for at least the above-noted reasons, claim 1 and its dependent claims 2, 3, 5, 6, 13 and 17 are allowable over the prior art.

Additionally, claims 4-6, 10-12, 14, 16 and 18 are allowable over the prior art for reasons analogous to those presented above for claim 1.

Argument 4: Shimizu does not teach or suggest a sorting device for detecting a category of the information to print, and automatically sorting out those ad data relating to the category of the information as described by claim 1.

Regarding claim 4, the Appellant argued in the April 12, 2004 Amendment that Shimizu does not disclose a sorting device for detecting a category of the information to print, and automatically sorting out those ad data relating to the category of the information. See page 8. The Examiner responded to this argument in the June 23, 2004 Office Action by pointing to a portion of the reference which relates to the relationship between memory sizes, i.e., col. 9, lines 62-67. See page 2 of the Office Action. Appellant submits that the relationship of memory sizes disclosed in Shimizu is unrelated to the above-mentioned feature of claim 4. The sorting device of claim 4 detects a category of information to print and automatically sorts ad data relating to the detected category of information. The size of a memory is not included in the claimed sorting device. Moreover, Shimizu does not disclose a sorting device having the features of claim 4. Accordingly, claim 4 is allowable over the prior art for this additional reason.

Appellant submits that claims 7-9 and 15 are allowable over the prior art for reasons analogous to those presented above in relation to claim 4.

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Appellant respectfully requests the members of the Board to reverse the rejection of all appealed claims and to find each of the claims allowable as defining subject matter which is patentable over the applied reference.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

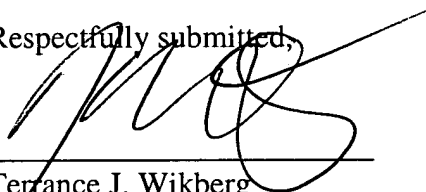
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Respectfully submitted,



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Date: February 23, 2005

CLAIMS APPENDIX

CLAIMS 1-18 ON APPEAL:

1. A network data terminal for printing information obtained from a network comprising:
a printer that is connectable to or incorporated into the data terminal, and is capable of printing on opposite sides of a recording sheet;
a memory device for storing ad data received from the network;
a device for allowing a user of the data terminal to choose whether to print the ad data on the same side of a recording sheet as the information or on the opposite side from the information;
a print control device that produces print image data for one side or for both sides from the information and the ad data in accordance with which side of the recording sheet the ad data is to print, and controls the printer in accordance with the print image data; and
a charge modification data sending device for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information.
2. A network data terminal as claimed in claim 1, further comprising:
a device for allowing the user to designate categories of the ad data to print with the information; and
a sorting device for sorting out those ad data relating to the designated categories, for use in producing the print image data.

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3. A network data terminal as claimed in claim 1 or 2, further comprising a device for allowing the user to select the amount of ad data to print with the information, wherein the charge is modified in accordance with the selected printing amount of ad data.

4. A network data terminal for printing information obtained from a network comprising:
a printer that is connectable to or incorporated into the data terminal, and is capable of printing on opposite sides of a recording sheet;

a memory device for storing ad data received from the network;

a sorting device for detecting a category of the information to print, and automatically sorting out those ad data relating to the category of the information;

a print control device that produces print image data from the information and the ad data sorted by the sorting device, and controls the printer in accordance with the print image data; and

a charge modification data sending device for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information.

5. A network data terminal as claimed in claim 1, further comprising:

a device for allowing a user of the data terminal to choose whether to print the ad data on the same side of a recording sheet as the information or on the opposite side from the information, wherein the print control device produces print image data for one side or for both sides in accordance with which side of the recording sheet the ad data is to print.

6. A network data terminal as claimed in claim 4 or 5, further comprising a device for allowing a user of the data terminal to select the amount of ad data to print with the information, wherein the charge is modified in accordance with the selected printing amount of ad data.

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7. A printing method for printing information obtained from a network by use of a printer that is connectable to or incorporated into a data terminal of the network, the method comprising the steps of:

storing ad data received from the network;
detecting a category of the information to print;
sorting out those ad data relating to the category of the information;
printing the sorted ad data along with the information; and
modifying charge for provision of the information in accordance with the amount of ad data printed with the information.

8. A printing method as claimed in claim 7, wherein the information obtained from the network is printed on an obverse side of a recording sheet, whereas the ad data is printed on a reverse side of the recording sheet.

9. A printing method as claimed in claim 7 or 8, further comprising the step of designating the amount of ad data to print with the information.

10. A printing method for printing information obtained from a network by use of a printer that is connectable to or incorporated into a data terminal of the network, the method comprising the steps of:

storing ad data received from the network;
printing the information on an obverse side of a recording sheet, while printing the ad data on a reverse side of the recording sheet; and

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modifying charge for provision of the information in accordance with amount of ad data printed with the information.

11. A printing method as claimed in claim 10, further comprising the step of designating categories of the ad data to print with the information.

12. A printing method as claimed in claim 10 or 11, further comprising the step of designating the amount of ad data to print with the information.

13. A network data terminal as claimed in claim 1, wherein the charge comprises a cost to be paid by the user.

14. A network data terminal as claimed in claim 4, wherein the charge comprises a cost to be paid by the user.

15. A printing method as claimed in claim 7, wherein the charge comprises a cost to be paid by the user.

16. A printing method as claimed in claim 10, wherein the charge comprises a cost to be paid by the user.

17. The network data terminal of claim 1, wherein the terminal operably receives the combination of video and audio information as a television signal.

18. The network data terminal of claim 4, wherein the terminal operably receives the combination of video and audio information as a television signal.

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EVIDENCE APPENDIX:

There has been no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

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RELATED PROCEEDINGS APPENDIX

There are no related proceedings